

Appl. No.: 10/771,901
Amdt. Dated: 02/02/2006
Off. Act. Dated: 11/02/2005

REMARKS/ARGUMENTS

Reconsideration of this application is respectfully requested in view of the foregoing amendments and discussion presented herein.

1. **Formal Drawing Submission.**

A set of seven (7) sheets of substitute formal drawings is included with the amendment to replace the seven (7) sheets of informal drawings submitted with the original patent application. The substitute drawings are intended as formal renditions of the informal drawings originally submitted, and as such contain no new matter. Each of these drawings is marked at the top as a "Replacement Sheet".

2. **Objection to Claim Numbering.**

Examiner noted that Claims 12-28 were improperly numbered, and indicated that these had thus been renumbered 11-27. The proper numbering 11-27 is reflected in the listing of claims contained herein and marked as currently amended.

It will be noted that Claim 11 was missing in the original application thus leading to the misnumbering of the remaining claims. Applicant apologizes for any inconvenience to the Examiner. All reference to these claims made hereafter will be in accord with these new claim numbers.

3. **Rejection of Claims 1-5, 10, 13-14, 17, 19-20, 23 and 25-27 under 35 U.S.C. §102(e).**

Claims 1-5, 10, 13-14, 17, 19-20, 23 and 25-27 were rejected under 35 U.S.C. §102(e) as being anticipated by Harris (U.S. Pat. No. 6,765,492 B2).

After carefully considering the grounds for rejection, the Applicant responds as follows.

Claims 1, 13, 14, 23 and 27. Claims 1, 13, 14, 23 and 27 are the independent claims in this group of claims.

Each of these independent claims has been amended to recite the invention with greater particularity. Specifically, the claims now include a process of executing a

Appl. No.: 10/771,901
Amdt. Dated: 02/02/2006
Off. Act. Dated: 11/02/2005

payment transaction in order to restore the disabled function of the device. A portion of these elements were previously recited in Claim 24.

Considering amended Claim 1, HARRIS does not teach "requesting a payment to restore device function; executing a payment transaction; and restoring the disabled function of said device in response to said payment transaction". Claims 13, 14 and 27 disclose limitations similar to those of Claim 1 relating to restoration of disabled function in the device based on a payment being executed.

Independent Claim 23 is a system claim which has been amended in keeping with the changes to the other independent claims. Specifically, amended Claim 23 now includes the description of a "*transaction module*" which is "*configured to handle a payment request in exchange for restoring the function of the device*". It will be noted that there is no teaching within Harris that comports to a transaction module configured for restoring the functionality in response to a transaction.

As these aspects of the amended claim are not disclosed by Harris, the reference can not be considered to anticipate them, wherein Claim 1, as well as the remaining independent claims are novel over the HARRIS reference.

Therefore, amended independent Claims 1, 13, 14, 23 and 27 are novel over the relied-upon reference, wherein the rejection of these claims and the claims which depend therefrom should be withdrawn.

4. Claims 1-27 are nonobvious.

Nor would the subject matter of Claims 1-27 be obvious to a person having ordinary skill in the art in view of in view of Harris, Gough, Himmel, and Creamer, either singly or in combination.

The Harris reference describes disabling devices within a given proximity, but does not teach any means or motivations for turning these device functions back on based on the fulfillment of a payment request.

The Gough reference (U.S. Pat. No. 6,823,199) describes a method of

Appl. No.: 10/771,901
Amdt. Dated: 02/02/2006
Off. Act. Dated: 11/02/2005

controlling a wireless device notification alert (see title), and the principle of operation of the invention involves sending a control signal discussed in the abstract as: *"The control signal may be used to either enable or disable the audible alert of a wireless device"*. Applicant found no discussion of restoring services based on executing a payment transaction.

The Himmel reference (U.S. Publ. No. 2003/0134627) describes controlling the use of various mobile electronic equipment (see abstract). More particularly Himmel discloses disabling one or more features of the electronic device based on a communication from a central system. Aspects of Himmel include substituting features from the central system for those being disabled in the wireless device, as seen in FIG. 8A block 248, and elsewhere.

The object of Himmel, as disclosed at the end of the background section (Paragraph [0009]) is to overcome the shortcomings of the prior art, in which the user *"is presented with no alternatives to the imposed constraints and thus becomes frustrated and annoyed by being denied the full use of the user's mobile electronic device."* To overcome this problem Himmel, as described in the Summary of the Invention (lower portion of paragraph [0010]), describes: *"The one or more features associated with the central control computer are substitutes for the one or more disabled features within the wireless electronic device..."*.

Accordingly, Himmel does not teach restoring functions of the device, or more particularly restoring functions in response to a payment transaction. Furthermore, Himmel is directed at different objects and operating principles and even teaches away from restoration, with the object of substitution from the central control computer.

The Creamer reference (U.S. Pat. No. 6,765,492) describes controlling access to a wireless network based on calling the individual and receiving payment verification. Unlike the other references, Creamer does not disclose disabling wireless devices based on location or type, but instead just provides a wireless access mechanism,

Appl. No.: 10/771,901
Amdt. Dated: 02/02/2006
Off. Act. Dated: 11/02/2005

which seems similar to that of attempting a collect call, but in a wireless paradigm. Creamer only describes a mechanism for providing wireless network access based on a payment, such as referring to paragraphs [0009]-[0010], including the statement: "*In particular, the method requires the user of a mobile computing device desiring access to a wireless network to provide a telephone number. This number can then be used to contact a telephone device. Subsequently, a user of the telephone device verifies the wireless access request and agrees to payment conditions. Upon receipt of this agreement, the wireless network grants (network) access to the mobile computing device.*"

The Creamer reference was put forth in a combination with Harris as the basis for rejecting Claim 24, drawn to "*a transaction module configured to handle a payment request in exchange for restoring the function of the device*". However, there is no teaching in either Harris or Creamer for conditional payment-based restoration of functionality within a device. The concept of paying to access a communication service is well known going back to pay phones. Attempting to combine Creamer with Harris in this manner is tantamount to indicating that any communication methods involving a payment are obvious based on Creamer because it discloses the use of a payment.

No teaching or motivation is found in either reference which would lead one of ordinary skill in the art to create the method and system described by the amended independent Claims, in particular executing a payment transaction in exchange for restoring functionality of the selected function of the device.

Accordingly, none of the references cited by the Examiner, nor any combinations thereof, suggest, teach or provides motivation for "requesting a payment to restore device function; executing a payment transaction; and restoring the disabled function of said device in response to said payment transaction", such as recited in Applicant's claims, such as Claim 1. Harris does not provide restorative aspects for the features, while none of the other references separately or in combination comport to these

Appl. No.: 10/771,901
Amdt. Dated: 02/02/2006
Off. Act. Dated: 11/02/2005

aspects of the invention.

Therefore, since none of these combinations result in Applicant's claim, and further since there is no suggestion, teaching or motivation which can be found in any of these references from which a person having ordinary skill in the art would find it obvious to modify the Harris reference to correspond to that described in the Applicant's claims. Claims 1-27 thus, recite structure which is patentable over the cited references for purposes of 35 U.S.C. § 103.

5. Traversal of Rejection of Claim 13; In re Donaldson.

The Applicant respectfully traverses the grounds for rejection, and cites *In re Donaldson*, 16 F.3d 1189, 1193 (Fed. Cir. 1994)(en banc) as the basis for the traversal. Claim 13 which is written in means plus function form pursuant to 35 U.S.C. §112, sixth paragraph, and therefore, must be interpreted during examination under *In re Donaldson*.

In rejecting Claim 13, as well as the claims that depend therefrom, the Examiner made no specific fact findings as to the scope of equivalents for the means plus function elements in the claims. Instead, the Examiner appears to have followed the provisions of MPEP § 2183 ("Making a Prima Facie Case of Equivalence"), which states:

If the examiner finds that a prior art element performs the function specified in the claim, and is not excluded by any explicit definition provided in the specification for an equivalent, the examiner should infer from that finding that the prior art element is an equivalent, and should then conclude that the claimed limitation is anticipated by the prior art element. The burden then shifts to applicant to show that the element shown in the prior art is not an equivalent of the structure ... disclosed in the application. *In re Mulder*, 716 F.2d 1542, 219 U.S.P.Q. 189 (Fed. Cir. 1983). No further analysis of equivalents is required of the examiner until applicant disagrees with the examiner's conclusion, and provides reasons why the prior art element should not be considered an equivalent.

Appl. No.: 10/771,901
Amdt. Dated: 02/02/2006
Off. Act. Dated: 11/02/2005

While the Examiner appears to have followed the provisions of MPEP §2183, such provisions are contrary to Federal Circuit law. The Federal Circuit has held that an examiner "construing means-plus-function language in a claim must look to the specification and interpret that language in light of the corresponding structure ... described therein, and equivalents thereof," *In re Donaldson*, 16 F.3d 1189, 1193 (Fed. Cir. 1994)(en banc), and in so ruling expressly denied that "the PTO is exempt from this mandate." *Id.* The Federal Circuit added that it was specifically overruling any precedent that suggested or held to the contrary. *Id.* at 1193-94. In response to the PTO's argument that the court's ruling conflicted with the principle that a claim should be given its broadest reasonable interpretation during prosecution, the Federal Circuit held that the *Donaldson* decision was setting "a limit on how broadly the PTO may construe means-plus-function language under the rubric of 'reasonable interpretation.'" *Id.* at 1194. In other words, an examiner's claim interpretation is not "reasonable" if it is not based on the specification's description of the implementation of the means element of the claim. The court then said, "Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such [means-plus-function] language when rendering a patentability determination." *Id.* at 1195.

Here, as in *Donaldson*, the Examiner is required by statute to look to the Applicant's specification and construe the "means" language as referring to corresponding means disclosed in the specification and equivalents thereof." See *id.* at 1195. However, the Examiner did not construe the means language of these claims, however. Nor did the Examiner find, on the basis of specific facts of record here, that the means disclosed in the Applicant's specification were equivalent to that of the cited references. Instead, as prescribed by MPEP §§ 2183-84, the Examiner simply presumed equivalence. The presumption methodology used here, which the MPEP prescribes, clearly conflicts with the requirements of the Federal Circuit's *Donaldson*

Appl. No.: 10/771,901
Amdt. Dated: 02/02/2006
Off. Act. Dated: 11/02/2005

decision. The approach taken by the Examiner in this case also conflicts with *In re Bond*, 931 F.2d 831 (Fed. Cir. 1990).

The very point of these cases is that, in this context, limitations from the specification control the interpretation of the claim. Under §112, paragraph 6, a means-plus-function element of a claim must be construed to mean that which is disclosed in the specification and its equivalents. In *Donaldson*, the Federal Circuit said that "our holding does not conflict with the general claim construction principle that limitations found only in the specification of a patent or patent application should not be imported or read into a claim." In other words, the court was saying that a §112, paragraph 6 "means" element does not need to be "imported or read into" a means-plus-function claim because the specification's limitations and their equivalents are already in the claim by virtue of §112, paragraph 6's command. Thus, the Federal Circuit said (16 F.3d at 1195): "What we are dealing with in this case is the construction of a limitation already in the claim in the form of a means-plus-function clause and a statutory mandate on how that clause must be construed."

Based on the foregoing, the Applicant respectfully submits that the rejection of Claim 13, as well as the claims that depend therefrom lacks proper foundation and that the rejection should be withdrawn. Those claims, each of which include means plus function limitations, should have been interpreted in view of the specification as required by *In re Donaldson*. If those claims had been so interpreted, they would have been allowable since the cited references do not, singly or in combination, teach, suggest or provide motivation or incentive for the subject matter recited in those claims.

6. Amendment of Claims 1-3 and 6-27.

Claims 1, 13, 14 and 27. Independent Claims 1, 13, 14 and 27 have been amended to include the use of requesting a payment, executing a payment, and restoring the disabled function based on the payment. Support for requesting a payment, executing the payment, and restoring function are found in other claims, such

Appl. No.: 10/771,901
Amdt. Dated: 02/02/2006
Off. Act. Dated: 11/02/2005

as claim 24, the drawings, such as in FIG. 6, as well as throughout the specification, including page 8, lines 1-2; page 11, lines 2-8; and so forth.

Independent Claim 14 was also amended to include "*detecting a device type*" as well as the location. Support being found in other claims within the application, such as Claim 1.

Claim 2. Dependent Claim 2 has been amended to incorporate both the location detection of original Claim 2 with disabling the function of the device based on the location of the device as recited in Claim 3 (which has been amended).

Claim 3, 15 and 16. Dependent Claims 3, 15 and 16 have been amended to recite "*further comprising exempting the disabling of functions of the device in response to detecting device characteristics indicative of emergency services*", or similar. Support for this aspect of the invention is found in the specification, such as at page 12, lines 6-19; page 14, lines 15-21; and so forth.

Claim 6. Dependent Claim 6 has been amended to recite with greater clarity what was meant by "*wherein the function is producing an audible alert*", and to incorporate the "*emitting an audible sound*" as was recited in Claim 7. Amended Claim 6 echoes the language of the base claim to make it clear that the audible alert function is the one subject to being disabled, and similarly but alternatively, that the emitting of an audible sound is selectively disabled.

Claim 7. Dependent Claim 7 has been amended to recite the aspect of disabling the ability to carry on a conversation on a cellular phone (or other devices having similar capabilities). Support for disabling the ability within a cellular phone of carrying on a conversation is found in the specification, such as page 18, lines 10-15, and so forth.

Claim 8. Dependent Claim 8 has been amended to recite the aspect of disabling image capture with greater clarity by using elements of the recitation in the base claim.

Appl. No.: 10/771,901
Amdt. Dated: 02/02/2006
Off. Act. Dated: 11/02/2005

Claim 9. Dependent Claim 9 has been amended to include other devices discussed within the specification that can include camera functions. Support for selectively disabling image capturing is described in the specification, such as at page 6, lines 11-13; page 10, lines 1-3; page 17, lines 1-2 and lines 10-13.

Claim 10. Dependent Claim 10 further recites "*a pager*". Support for "*a pager*" is found in the specification, such as at page 15, lines 21-23.

Claim 11-27. Dependent Claims originally numbered 12-28 were renumbered 11-27, as there was not an original Claim 11 in the application. Both claim numbering and antecedent basis within the claim numbering has been corrected.

Claim 12. Dependent Claim 12 has been amended to recite types of payment transactions, specifically, those that can be characterized in the manner of a credit card authorization or as a micro-payment authorization. Support for these aspects is found in the specification, such as at page 16, lines 14-16.

Claims 20 and 24. Dependent Claims 20 and 24 have been amended to recite under what conditions the indiscriminate disabling is performed, or the device is turned off. Support for the confirmation and indiscriminant disablement is found in the specification, including page 18, lines 3-9.

Claim 23. Independent Claim 24 was amended to include "a transaction module" configured to handle a payment request in exchange for restoring the function of the device which was disabled". Support for this is provided in Claim 24, as well as in the drawings, for instance FIG. 6, and throughout the specification including page 8, lines 1-2; page 11, lines 2-8; and elsewhere.

7. Amendments Made Without Prejudice or Estoppel.

Notwithstanding the amendments made and accompanying traversing remarks provided above, Applicants have made these amendments in order to expedite allowance of the currently pending subject matter. However, Applicants do not acquiesce in the original ground for rejection with respect to the original form of these

Appl. No.: 10/771,901
Amdt. Dated: 02/02/2006
Off. Act. Dated: 11/02/2005

claims. These amendments have been made without any prejudice, waiver, or estoppel, and without forfeiture or dedication to the public with respect to the original subject matter of the claims as originally filed or in their form immediately preceding these amendments. Applicants reserve the right to pursue the original scope of these claims in the future, such as through continuation practice, for example.

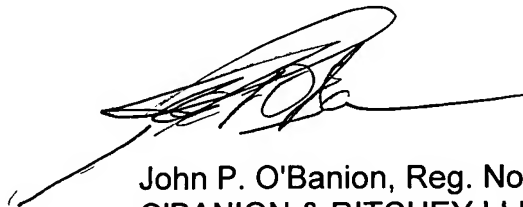
8. Conclusion.

Based on the foregoing, Applicants respectfully request that the various grounds for rejection in the Office Action be reconsidered and withdrawn with respect to the presently amended form of the claims, and that a Notice of Allowance be issued for the present application to pass to issuance.

In the event any further matters remain at issue with respect to the present application, Applicants respectfully request that the Examiner please contact the undersigned below at the telephone number indicated in order to discuss such matter prior to the next action on the merits of this application.

Date: 2/2/06

Respectfully submitted,



John P. O'Banion, Reg. No. 33,201
O'BANION & RITCHEY LLP
400 Capitol Mall, Suite 1550
Sacramento, CA 95814
(916) 498-1010

Attachment: Replacement Sheets (Sheet 1 through Sheet 7)